REMARKS

I.   Summary

Claims 1-20 are pending in the application. In the non-final Office Action mailed March 15, 2005 (hereinafter "Office Action"), claims 1-14, 16, and 18-20 were rejected. Claims 15 and 17 were objected to, but indicated as allowable if rewritten in independent form. The Applicant thanks the Examiner for this indication. Claim 20 has been amended. No new matter has been added. The issues in the Office Action are:

- Claims 1-14, 16, and 18-20 are rejected under 35 U.S.C. § 103(a) as unpatentable over *Moore* (U.S. Patent No. 6,456,729) in view of *Rhoads* (U.S. Patent No. 6,580,819).

Applicant respectfully traverses all outstanding rejections and objections in view of the remarks contained herein. Applicant requests that the rejections and objections be withdrawn and all claims passed to issue.

II.   Claim Rejections under 35 U.S.C. § 103(a)

Claims 1-14, 16, and 18-20 are rejected under 35 U.S.C. § 103(a) as unpatentable over *Moore* in view of *Rhoads*.

Applicant renews the arguments made in the January 3, 2005 Amendment after Final Action that *Moore* and *Rhoads* do not teach or suggest all elements of claims 1-14, 16, and 18-20 and that these claims are patentable over the 35 U.S.C. § 103(a) rejection of record. Applicant respectfully traverses the Examiner's characterization of Applicant's argument regarding claim 1 as "in essence that [the] combination of Moore and Rhoads does not teach or suggest claimed limitation "create a second data from a first data"". *See* Office Action, paragraph 3. Applicant also respectfully traverses the Examiner's statements regarding the *Moore* and *Rhoads* references in Item 3 of the Office Action, pages 2-3 for the reasons provided below.

To establish a *prima facie* case of obviousness, three basic criteria must be met. *See* M.P.E.P. § 2143. First, there must be some suggestion or motivation, either in the references

themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. Without conceding the first or second criteria, Applicant respectfully asserts that the rejection does not satisfy the third criteria.

Not All Limitations

Claim 1 recites "creating from an object a first data set having data in a first arrangement" and "...comparing said object presented for validation to both said first and said second data arrangements." *Moore* teaches using clear text for an identifying message. *See Moore*, col. 11, lines 8-11. The clear text is established by a host computer. *See id.* The Examiner indicates that the clear text of *Moore* is comparable to the first data set recited in claim 1. *See* Office Action, page 3, line 1. Applicant respectfully disagrees, as *Moore* does not teach or suggest "creating from an object a first data set having data in a first arrangement" and "...comparing said object presented for validation to both said first and said second data arrangements." Accordingly, *Moore* does not teach or suggest all limitations of claim 1.

Rhoads does not cure the deficiencies of *Moore* with respect to claim 1. *Rhoads* teaches creating digital data (15) from banknotes. *See Rhoads*, col. 3, lines 23-64. The digital data (15) is analyzed to extract embedded watermark data or visible structures (22). *See id.* The Examiner indicates that the digital data (15) of *Rhoads* is comparable to the first data set recited in claim 1. *See* Office Action, page 3, line 1. Applicant respectfully disagrees. Among other things, the digital data (15) of *Rhoads* is not taught or suggested as being compared to an object presented for validation. Accordingly, *Rhoads* does not teach or suggest "creating from an object a first data set having data in a first arrangement" and "...comparing said object presented for validation to both said first and said second data arrangements." Thus, *Moore* in view of *Rhoads* does not teach or suggest all limitations of claim 1.

Claim 18 recites "a first data set having data in a first data arrangement created from an object" and a "data processing system determining whether the data on said object is consistent with the data of the first and second data arrangements." As shown above, *Moore*

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text is established by a host computer. *See id.* Accordingly, *Moore* does not teach or suggest at least the above-recited limitation of claim 18. As shown above, *Rhoads* teaches creating digital data (15) from banknotes. *See Rhoads,* col. 3, lines 23-64. The digital data (15) is analyzed to extract embedded watermark data or visible structures (22). *See id.* Accordingly, *Rhoads* does not teach or suggest at least the above-recited limitation of claim 18. *Moore* in view of *Rhoads* does not teach or suggest all limitations of claim 18. Thus, claim 18 is not obvious over the cited references.

Amended claim 20 recites "a first data arrangement, created from an object" and "determining whether data on an object presented for validation is consistent with the data of the first and second data arrangement." As shown above, *Moore* teaches using clear text for an identifying message. *See Moore,* col. 11, lines 8-11. The clear text is established by a host computer. *See id.* Accordingly, *Moore* does not teach or suggest at least the above-recited limitation of claim 20. As shown above, *Rhoads* teaches creating digital data (15) from banknotes. *See Rhoads,* col. 3, lines 23-64. The digital data (15) is analyzed to extract embedded watermark data or visible structures (22). *See id.* Accordingly, *Rhoads* does not teach or suggest at least the above-recited limitation of claim 20. *Moore* in view of *Rhoads* does not teach or suggest all limitations of claim 20. Thus, claim 20 is not obvious over the cited references.

Claims 2-14, 16, and 19 depend from base claims 1 and 18, respectively, and thus inherit all limitations of their respective base claims. Each of claims 2-14, 16, and 19 sets forth features and limitations not recited by the combination of *Moore* and *Rhoads.* Thus, the Applicant respectfully asserts that for the above reasons claims 2-14, 16, and 19 are patentable over the 35 U.S.C. § 103(a) of record.

No Motivation

The Examiner states on page 3 of the Office Action that it would have been obvious to modify *Moore* with the teachings of *Rhoads* because "it provides a method to track subsequent use of digital images including derivative images, which identify the source or ownership of images and distinguish between different copies and verify the authenticity of the document from forgery." Applicant respectfully traverses this assertion.

It is well settled that the fact that references can be combined or modified is not sufficient to establish a prima facie case of obviousness. *See* M.P.E.P. § 2143.01. The language of the recited motivation is circular in nature, stating that it is obvious to make the modification because it is obvious to achieve the result. Such language is merely a statement that the reference can be modified, and does not state any desirability for making the modification. The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *See* In re Mills, 916 F.2d 680, 16 U.S.P.Q.2d 1430 (Fed. Cir. 1990), as cited in M.P.E.P. § 2143.01. Thus, the motivation provided by the Examiner is improper, as the motivation must establish the desirability for making the modification.

III.   Conclusion

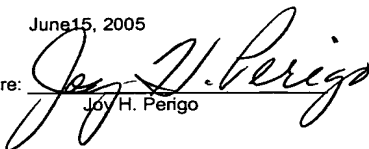In view of the above, Applicant believes the pending application is in condition for allowance.

Applicant believes no fee is due with this response. However, if a fee is due, please charge our Deposit Account No. 08-2025, under Order No. 10004878-1, from which the undersigned is authorized to draw.

Dated: June 15, 2005

I hereby certify that this correspondence is being deposited with the U.S. Postal Service as Express Mail, Airbill No. EV482708032US, in an envelope addressed to: MS Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on the date shown below.

Dated: June 15, 2005

Signature: _____
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Respectfully submitted,

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